

REMARKS/ARGUMENTS

Claims 1-17 are pending. By this Amendment, claims 1 and 3 are amended. Support for the amendments to claims 1 and 3 can be found, for example, in the present specification at page 6, lines 9 to 13, and in original claims 1 and 3. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) over EP 1 069 142 to Morschhauser et al. ("Morschhauser")\* in view of U.S. Patent No. 4,919,923 to Hoeffkes et al. ("Hoeffkes"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] composition suitable for topical application comprising an oily phase dispersed in an aqueous phase, at least one wax, and at least one non-crosslinked amphiphilic polymer, said polymer comprising from: (a) 85 mol% to 99 mol% of 2-acrylamido-2-methylpropanesulphonic acid (AMPS) units of formula (I) ... and (b) 1 mol% to 15 mol% of units of formula (III) ..." (emphasis added). Morschhauser and Hoeffkes do not disclose or suggest such a composition.

As in Applicants' previous response and conceded in the Office Action, Morschhauser fails to disclose a composition including an oily phase dispersed in an aqueous phase, at least one wax, and the particular non-crosslinked amphiphilic polymer of claim 1. See Office Action, pages 10 to 11. The Office Action asserts that it would have been obvious, in view of the teachings of Hoeffkes, to add a wax to the oil-in-water emulsions in Morschhauser including AMPS. See Office Action, page 11. Applicants respectfully disagree.

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\* Discussion of Morschhauser is made with reference to U.S. Patent No. 6,645,476, which the Office Action indicates is an English-language equivalent.

As correctly pointed out in the Office Action, Hoeffkes discloses that various thickening agents, including waxes, may be employed to improve the stability of an emulsion. *See Hoeffkes*, column 1, lines 17 to 23. However, the compositions of Hoeffkes are entirely different from the compositions of Morschhauser. In particular, the oil-in-water emulsions of Hoeffkes, which may include waxes, are based on a dialkyl ether oily phase. *See Hoeffkes*, column 1, lines 55 to 58. By contrast, the two oil-in-water emulsions in Morschhauser do not include such an oily phase. *See Morschhauser*, column 19, line 20 to column 20, line 8. Hoeffkes' disclosure that waxes are suitable thickeners in a particular oil-in-water emulsion does not suggest that such waxes would be suitable additives to the different oil-in-water emulsions disclosed in Morschhauser. A *prima facie* case of obviousness has not been made.

As discussed in Applicants' previous response, even if a *prima facie* case of obviousness were made, such case would be rebutted by the evidence of unexpected superior results in the present specification and the Declaration Under 37 C.F.R. §1.132 ("Declaration") filed on March 5, 2008 – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." *See* MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Office Action asserts that the evidence in the present specification and the Declaration is insufficient to overcome the rejection because: (a) the comparison of compositions with and without wax in Example 1 and Comparative Example 1 of the present specification is deficient because the oily phase of the composition of Example 1 includes components other than wax that could contribute to stability; and (b) the data in the present specification and Declaration are not commensurate in scope with the claims. *See* Office Action, pages 13 to 14. Applicants address these objections below in turn.

With respect to the possibility that the desirable results discussed in the previous response could be attributed to a component other than wax, Applicants commend attention to Example 5 and Comparative Example 1 of the present specification. *See* present specification, pages 35 to 36. The composition of Example 5 and the composition of Comparative Example 1 are identical, except that the composition of Example 5 includes beeswax while the composition of Comparative Example 1 includes a cyclic silicone. However, the composition of Example 5 forms a stable oil-in-water emulsion, while the composition of Comparative Example 1 is unstable. *See* present specification, page 36, line 23 to page 37, line 2. This evidence directly rebuts the Office Action's assertion that the improved performance demonstrated by the composition of claim 1 could be attributed to a factor other than the presence of wax. The evidence in the present specification and the Declaration demonstrate the nonobviousness of the composition of claim 1 over the compositions of Morschhauser and Hoeffkes.

With respect to the Office Action's assertion that the data in the present specification and the Declaration are not commensurate in scope with the present claims, while Applicants do not necessarily agree with the assertion, claim 1 has been amended to more closely align in scope with the data. In particular, claim 1 has been amended to define the at least one non-crosslinked amphiphilic polymer in a manner that more closely aligns with the polymers employed in the Examples in the present specification and the Declaration. Applicants submit that the data in the present specification and the Declaration, which demonstrate the unexpected, superior results achieved by compositions according to the present invention in comparison with compositions such as in Morschhauser and Hoeffkes, are commensurate in scope with amended claim 1.

Claim would not have been rendered obvious by Morschhauser and Hoeffkes. Claims 2-17 depend from claim 1 and, thus, also would not have been rendered obvious by

Morschhauser and Hoeffkes. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

A. 674 Patent

The Office Action rejects claims 1-17 under the judicially created doctrine of obviousness-type double patenting over claims 1-5, 22-27 and 29-49 of U.S. Patent No. 6,905,674 in view of Hoeffkes. Applicants respectfully traverse the rejection.

As conceded in the Office Action, the claims of the 674 patent do not require a wax. See Office Action, page 5. Accordingly, for the reasons discussed above with respect to the rejection over Morschhauser and Hoeffkes, the claims of the 674 patent do not render obvious claim 1 of the present application, and Hoeffkes does not remedy the deficiencies of the claims of the 674 patent. Claims 2-17 of the present application depend from claim of the present application and, thus, also are not obvious over the claims of the 674 patent and Hoeffkes.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. 013 Application

The Office Action provisionally rejects claims 1-10 and 12-17 under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent Application No. 10/813,013 in view of Hoeffkes. Applicants respectfully traverse the rejection.

As conceded in the Office Action, the claims of the 013 patent do not require a wax. See Office Action, page 7. Accordingly, for the reasons discussed above with respect to the

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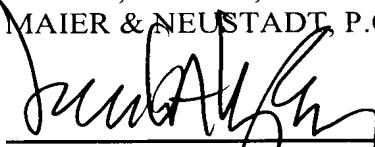
rejection over Morschhauser and Hoeffkes, the claims of the 013 patent do not render obvious claim 1 of the present application, and Hoeffkes does not remedy the deficiencies of the claims of the 013 patent. Claims 2-17 of the present application depend from claim of the present application and, thus, also are not obvious over the claims of the 013 patent and Hoeffkes.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

### Conclusion

For the foregoing reasons, Applicants submit that claims 1-17 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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